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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,058	04/25/2007	Shinji Okuhara	20696-00097-US1	2438
30678 7590 08/13/2008 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20036				
EXAMINER CERNOCH, STEVEN MICHAEL				
ART UNIT		PAPER NUMBER		
3752				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/586,058

**Applicant(s)**

OKUHARA ET AL.

**Examiner**

STEVEN CERNOCH

**Art Unit**

3752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CI/CD)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 7/14/2006

Art Unit: 3752

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As the claim states "wherein the coating layer is a C2 coating layer" there isn't sufficient information in the specification nor in the stated claim to enable one skilled in the art to apply such a limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3752

Re claim 3, as the claim states "wherein the coating layer is a C2 coating layer" it is not understood what applicant means in regards to this limitation and therefore claim shall be examined as best understood by examiner.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 5-7, 10-11 and 13-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Niwa et al. (US Pub No 2004/0000601).

Re claim 1, Niwa et al. shows a fuel injection valve (Fig. 2, 1) having a nozzle body (10) with a nozzle hole(s) (43) at its tip that is opened and closed by a nozzle needle (50) housed in the nozzle body, a fuel injection valve characterized in that an area of contact between the nozzle needle and a seat on the nozzle body is provided with a coating layer (Fig. 1, 52) to reduce the frictional resistance with the nozzle body.

Re claim 2, Niwa et al. shows wherein the coating layer is provided over the entire surface of the nozzle needle (Fig. 12, 52).

Re claim 3, as best understood, Niwa et al. shows wherein the coating layer is a C2 coating layer (paragraph 0037, lines 10-12).

Art Unit: 3752

Re claim 5, Niwa et al. shows wherein the coating layer is provided as a DCL thin film (paragraph 0037, lines 10-12).

Re claims 6, 10 and 11, Niwa et al. shows wherein the coating layer has a thickness of from 0.1  $\mu\text{m}$  to 30  $\mu\text{m}$  (paragraph 0039).

Re claims 7, 13 and 14, Niwa et al. shows wherein the coating layer has a thickness of from 1  $\mu\text{m}$  to 5  $\mu\text{m}$  (paragraph 0039).

***Claim Rejections - 35 USC § 102 / 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3752

Claims 4, 12 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Niwa et al. (US Pub No 2004/0000601).

Re claim 4, Niwa et al. shows wherein the coating layer is a hard, amorphous carbon film (paragraph 0037, lines 10-12).fabricated by ionization vapor deposition.

The coating shown by Niwa meets all of the structural limitations as set forth in applicant's claim 4; however Niwa describes a process of carbonizing.

The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious variant from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

Appropriate correction is required.

Re claim 12, Niwa et al. shows wherein the coating layer has a thickness of from 0.1  $\mu\text{m}$  to 30  $\mu\text{m}$  (paragraph 0039).

Re claim 15, Niwa et al. shows wherein the coating layer has a thickness of from 1  $\mu\text{m}$  to 5  $\mu\text{m}$  (paragraph 0039).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3752

invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 9 and 16-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa et al. (US Pub No 2004/0000601) in view of Dotmar Engineering Plastic Products (9/4/2003).

Re claims 8, 9 and 16-20, Niwa et al. does not show wherein a coefficient of friction between the coating layer and the nozzle body is not more than 0.2 or 0.1, however, PTFE is a known material with a known coefficient of friction of 0.1 or less and as Dotmar Engineering Plastic Products shows it can be less than 0.2 and 0.1.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have the motivation to modify the coating of Niwa et al. with the coefficient of friction of Dotmar as it's a known material property.

Art Unit: 3752

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN CERNOCH whose telephone number is (571)270-3540. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571)272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. C./

Examiner, Art Unit 3752



Art Unit: 3752

/Len Tran/

Supervisory Patent Examiner, Art Unit 3752